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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,526	07/29/2003	Arthur E. Onweller	1067.01001	1525

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EXAMINER

BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,526

Applicant(s)

ONWELLER, ARTHUR E.

Examiner

Sherman D. Basinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-17 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the lines, numbers and letters are not uniformly thick and well defined. The reference numerals throughout the drawings are of an informal nature such that the thickness of the ink used to form the numerals varies, thus the reference numerals are not uniformly thick and well defined. Many of the figures have copy smears and marks throughout, especially figures 2-4, 6, 7 and 11. In figure 2, the reference numerals are crowded so closely together on the left side of the figure they almost run together. In figure 8, the lines outlining closure 24 are incomplete especially where the lead line for reference numeral 64 ends. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 13 as filed December 27, 2004 is objected to because of the following informalities: claim 13 as filed December 27, 2004 does not comply with the revised amendment practice effective July 30, 2003. When a claim is canceled, the text of the claim should not be submitted. Appropriate correction is required.

Applicant should have canceled claim 13 as follows: 13. (canceled).

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1 and 14-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13-17 of copending Application No. 10/710378.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Claims 19, 21, 22, 23 and 24 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20, 22, 23, 24 and 25 of copending

Application No. 10/710378. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Paragraph 19a of the instant application defines "a lock" while paragraph 20a of application 10/710378 defines "a lockable element". Because a lock is a lockable element, the same invention is being claimed in claim 19 of the instant application and claim 20 of application 10/710378.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 10/710378. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 of application 10/710378 defines the step of claim 20 of the instant application and adds "using said lockable element". Thus, in using a marine mooring line vermin shield as set forth in claim 21 of the application 10/710378 applicant would be using a marine mooring line vermin shield as set forth in claim 20 of the instant application, and it would have been obvious at the

time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to do so. Motivation is to use the vermin shield as defined in claim 20 of application 10/710378 to keep rodents off of a boat.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 2-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-12 of copending Application No. 10/710378. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

In claims 2-12, all depending from claim 1, the instant application further defines a marine mooring line vermin shield having a *closure second end which is also-sized and configured to removably engageably receive an optional aperture insert* wherein said disc of claim 1 resists axial movement wherein said disc of claim 1 is constructed of a material with a mass density less than water such that said marine mooring line vermin shield floats in water, wherein said disc is constructed of materials selected from the group consisting essentially of polyethylene, polypropylene, and polyurethane materials, wherein said closure of claim 1 is constructed of a corrosion resistant material, a lock to secure said closure in the closed state, said lock is constructed of a corrosion resistant material, said disc face of claim 1 is a smooth substantially continuous surface with the exception

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of the marine mooring line protruding therefrom, when said closure is in the closed state, the vermin encounters said disc face while crawling along the mooring line to help prevent passage of the vermin beyond said disc face, said disc face has an area for placement of a pleasure craft registration number, said means for urging said closure of claim 1 is pivotally oriented substantially parallel to the slot radial axis of claim 1, a rod with a pivotal axis that is oriented substantially parallel to the slot radial axis of claim 1, a spring element, and wherein said rod and spring element are constructed of a corrosion resistant material.

Application 10/710378 defines in claims 2-12 a marine mooring line vermin shield as defined in claim 1 of the instant application except for *a closure second end which is also-sized and configured to removably engageably receive an optional aperture insert* wherein said disc of claim 1 is constructed of a material with a mass density less than water such that said marine mooring line vermin shield floats in water, wherein said disc is constructed of materials selected from the group consisting essentially of polyethylene, polypropylene, and polyurethane materials, wherein said closure of claim 1 is constructed of a corrosion resistant material, a lockable element to secure said closure in the closed state, said lockable element is constructed of a corrosion resistant material, said disc face of claim 1 is a smooth substantially continuous surface with the exception of the marine mooring line protruding therefrom, when said closure is in the closed state, wherein the vermin encounters said disc face while crawling

along the mooring line to help prevent passage of the vermin beyond said disc face, said disc face has an area for placement of a pleasure craft registration number, said means for urging said closure of claim 1 is pivotally oriented substantially parallel to the slot radial axis of claim 1, a rod with a pivotal axis that is oriented substantially parallel to the slot radial axis of claim 1, a spring element, and wherein said rod and spring element are constructed of a corrosion resistant material.

In view of claims 2-12 of application 10/710328, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide the marine mooring line vermin shield of claim 1 of the instant application with the disc of claim 1 constructed of a material with a mass density less than water such that said marine mooring line vermin shield floats in water, wherein said disc is constructed of materials selected from the group consisting essentially of polyethylene, polypropylene, and polyurethane materials, wherein said closure of claim 1 is constructed of a corrosion resistant material, a lockable element to secure said closure in the closed state, said lockable element is constructed of a corrosion resistant material, said disc face of claim 1 is a smooth substantially continuous surface with the exception of the marine mooring line protruding therefrom, when said closure is in the closed state, wherein the vermin encounters said disc face while crawling along the mooring line to help prevent passage of the vermin beyond said disc face, said disc face has an area for placement of a pleasure craft registration

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number, said means for urging said closure of claim 1 is pivotally oriented substantially parallel to the slot radial axis of claim 1, a rod with a pivotal axis that is oriented substantially parallel to the slot radial axis of claim 1, a spring element, and wherein said rod and spring element are constructed of a corrosion resistant material. Motivation to do so is to provide a marine vermin mooring shield which will remain functional in the environment in which the mooring line is being used, will be able to be easily put on the mooring line and locked and which will be able to be easily identified if stolen or lost.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

9. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


10. All of the claims which were indicated as being allowable in the first office action are now rejected under double patenting in view of applicant's copending application 10/7710378.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sherman D. Basinger
Primary Examiner
Art Unit 3617
2/2/05

Monday, February 07, 2005